

REMARKS

The Examiner's Action mailed on April 17, 2003 has been received and its contents carefully noted.

In this Amendment, Applicants have amended claim 1. Claims 1, 9 and 10 are the independent claims. Claims 1-20 remain pending in the application. For at least the following reasons, it is submitted that this application is in condition for allowance.

Initially, it is noted that the Examiner has made the Restriction Requirement final. The Examiner's attention is thus directed to Applicants' response to this Restriction Requirement, which made clear that Applicants' response included a Provisional Petition to the Commissioner to review the Examiner's requirement, should the Examiner's requirement subsequently be made final. Since the Examiner's requirement has been made final, it is assumed that the Petition has been forwarded to the Commissioner for review of the Examiner's requirement. Acknowledgement of such action is hereby requested.

The Examiner's Action has also stated that the declaration is defective for being torn. However, Applicants are unaware of any requirement that a torn page of the declaration renders such declaration defective. Moreover, it is noted that the MPEP specifically states that in "the first Office Action the examiner must point out every deficiency in a declaration..." (see MPEP 602.03, emphasis added). Since this is the second Office Action on the merits, and since the Examiner did not state in the first office action that there were any deficiencies in the declaration, such as a torn page, Applicants can only assume that the declaration became torn while in the possession of the Office. In further support of this assumption, it is noted that the copy of the

declaration in Applicants' file does not show any torn pages that may have been in the original declaration. Since it is clear that any damage to the declaration occurred while the declaration was in the possession of the Office, it is hereby submitted that the declaration, as originally submitted, was not defective. Nevertheless, for the Examiner's convenience, attached hereto is a copy of the original declaration, which copy has no torn pages.

The Examiner's Action has rejected claims 1 and 9 as being anticipated by *Abiko* (JP 10208301A). It is submitted that these claims are patentably distinguishable over the cited reference for at least the following reasons.

It is well settled that a reference may anticipate a claim within the purview of 35 U.S.C. §102 only if all the features and all the relationships recited in the claim are taught by the reference structure either by clear disclosure or under the principle of inherency.

Applicants' independent claim 1 is directed to a first and a second stacked disk, and a powder disposed between the disks. The powder facilitates removal of the first disk from the second disk, and protects the first disk and the second disk when the second disk is stacked upon the first disk.

As revealed by Applicants' specification, prior to Applicants' claimed invention, it was conventional to transport stacked disks using a piece of paper between adjacent disks. The paper would prevent the surface of one disk from scratching the surface of an adjacent disk, and would facilitate separation of the disks from the stack. However, the use of such paper is problematic to the end user. For example, some of the paper would invariably end up in undesired locations, such as being caught in the workings of

an expensive piece of manufacturing equipment causing possible equipment damage and loss of thru-put, or as debris on the floor (see page 3, line 3 through page 4, line 7). Applicants' claimed invention overcomes these and other problems by providing a powder between the adjacent disks. In particular, the claimed powder serves as a cushion between the disks, so that the disks will not damage one another. Moreover, the powder may absorb impacts to the stack caused by improper handling, thus protecting the disks from breakage. Further, the use of the powder will prevent close forces of attraction such as polarization and coulombic forces from holding the disks together, thus facilitating the separation of the disks from the stack of disks (see page 9, lines 17-22). Neither Applicants' claimed invention, nor the problems sought to be solved by Applicants' claimed invention, nor the advantages associated with Applicants' claimed invention, are disclosed or suggested by the cited reference.

Abiko discloses an information recording medium that includes a first substrate adhered to a second substrate. In order that the recording medium can be used in dark places, a luminous material is added to the adhesive that bonds the first substrate to the second substrate. The reference discloses that the luminous material is an inorganic fluorescent pigment that is disposed in the adhesive.

However, and in contrast to the present invention, there is no disclosure from this reference that the luminous material facilitates removal of the first substrate from the second substrate, as recited by claim 1. In fact, this reference specifically teaches away from this claimed feature, since the luminous material is added to an adhesive, so that the resulting mixture would prevent the removal of the first substrate from the second substrate. This is completely opposite to the goal that is achieved using Applicants'

claimed invention. As such, it is submitted that claim 1 has not been anticipated by, or other rendered obvious, in view of the cited reference.

Moreover, Applicants' claim 9 is submitted to be patentably distinguishable over the cited reference for at least the following reasons. Claim 9 recites a combination that includes a plurality of disks including a first disk and a second disk stacked upon the first disk. The combination also includes a powder disposed between the first disk and the second disk. Claim 9 also recites that the first disk is spaced apart from the second disk by only the powder.

In contrast, and as noted above, the cited reference discloses adding a luminous material to the adhesive that bonds the first substrate to the second substrate. Thus, the first substrate is separated from the second substrate by both the luminous material (i.e., the powder) and by the adhesive. Thus, this reference does not disclose a first disk that is spaced apart from a second disk by only a powder, and it is hereby submitted that the Examiner's Action has failed to establish a *prima facie* case of anticipation against claim 9. It is thus requested that these claims be allowed, and it is further requested that these rejections be withdrawn.

The Examiner's Action has also rejected claims 2-8 as being obvious in view of *Abiko*. Because claims 2-8 depend from claim 1, which as discussed above is patentably distinguishable over the cited reference, it is submitted that these claims are likewise patentably distinguishable over the cited reference.

Moreover, it is submitted that claims 2-8 are further patentably distinguishable over the cited reference for the following additional reasons.

The Examiner's Action has stated that *Abiko* discloses a plurality of disks that are spaced apart, and a powder disposed between the disks. However, claim 3 recites that the powder spaces the first disk from the second disk. In contrast, while the first substrate is spaced apart from the second substrate, it is not the luminous material that causes the first substrate to be spaced apart from the second substrate. Instead, it is the adhesive material that spaces the first substrate apart from the second substrate.

Further, in rejecting claims 2 and 4-8, the Action relies on the holdings from certain case law for the proposition that it is within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

However, the Federal Circuit has specifically stated that cases that state such *per se* rules should not be applied in rejecting the claims of a patent application. In particular, the court decisions cited in the Action hark back to a time when the presence or absence of "invention" was used as the basic test for patentability, and so-called "negative rules of invention" were developed as an aid to determine when "invention" was present. These negative rules of invention sometimes led to reasonable results but they were also frequently applied in a mechanical way (such as in the present case) to deny patent protection for meritorious inventions. This is one reason why Congress switched away from the "invention" test to the current "non-obviousness" test for patentability. It took awhile for the courts to wean themselves away from the negative rules of invention, but the negative rules are now thoroughly discredited as tests for patentability. Graham v. John Deere, 148 USPQ 459 (S. Ct., 1966) makes it quite clear

that non-obviousness, not the presence or absence of "invention," is the basic test for patentability.

Moreover, in its decision in In re Ochia, 37 USPQ2d 1127 (1995), the Court of Appeal for the Federal Circuit stated (at page 1133):

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention – including all of its limitation – with the teachings of the prior art, flouts section 103, and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention *as claimed* in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any *per se* rules of obviousness, just at those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract *per se* rules from decisions that disavow precisely such extraction.

It is respectfully submitted that the position taken by the Examiner's Action, and its reliance on court decisions in an apparent effort to avoid performing a complete search and to avoid explaining **why** an ordinarily skilled person would have had an incentive to modify the prior art so as to achieve the present invention, run contrary to the above-quoted guidelines of the CAFC.

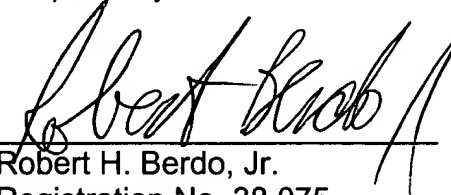
Moreover, claims 5, 6 and 7 specifically define features of the powder. The Examiner states that it would have been obvious to provide the product of *Abiko* with the powder recited in claims 5, 6 and 7, as a matter of obvious design choice. However, unless the powders recited in claims 5, 6 and 7 are a luminous material (and they are

not believed to be), then one skilled in the art certainly would NOT have substituted the powder recited in claims 5, 6 and 7 for the luminous material of *Abiko*, since *Abiko* discloses a luminous material is required to allow the recording medium to be used in the dark. As such, it is requested that these claims be allowed, and that this rejection be withdrawn.

It is submitted that this application is in condition for allowance. Such action, and the passing of this case to issue are requested.

Should the Examiner feel that a conference would help to expedite the prosecution of this application, the Examiner is hereby invited to contact the undersigned counsel to arrange for such an interview.

Respectfully submitted,



Robert H. Berdo, Jr.
Registration No. 38,075
RABIN & BERDO, PC
Customer No. 23995
Telephone: 202-371-8976
Facsimile: 202-408-0924

June 20, 2003
Date

RHB:crh

AMENDMENT

09/840,077